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VB

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/352,466

07/13/99

BROUDY

V

A-195CDD

HM12/0830

STEVEN M ODRE
AMGEN INCORPORATED
1840 DEHAVILLAND DRIVE
THOUSAND OAKS CA 91320-1789

EXAMINER

HELMS, L

ART UNIT

PAPER NUMBER

1642

6

DATE MAILED:

08/30/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/352,466

Applicant(s)

Broudy et al

Examiner
Larry R. Helms Ph.D.

Group Art Unit
1642



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire NONE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-25 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-25 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6 and 22-25, drawn to a monoclonal antibody and hybridoma , classified in class 530, subclass 388.82.
 - II. Claims 7-10, drawn to a method of purifying hematopoietic cells, classified in class 435, subclass 7.1, for example.
 - III. Claim 11, drawn to a method of reconstituting hematopoietic cells, classified in class 435, subclass 1.1, for example.
 - IV. Claim 12, drawn to a method of gene therapy, classified in class 514, subclass 44.
 - V. Claim 13, drawn to a method of separating normal cells from neoplastic leukemia cells, classified in class 435, subclass 2, for example.
 - VI. Claims 14-15, drawn to a method of treating leukemia cells, classified in class 424, subclass 178.1.
 - VII. Claims 16-17, drawn to a method of treating solid tumors, classified in class 424, subclass 178.1.
 - VIII. Claims 18-20, drawn to a method of determining the presence of SCF receptors in a cell, classified in class 435, subclass 7.1, for example.

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IX. Claim 21, drawn to a method of modifying the sensitivity to cell cycle-specific chemotherapeutic agents, classified in class 424, subclass 130.1, for example.

2. The inventions are distinct, each from the other because of the following reasons:

The methods of Inventions II-IX differ in the method objectives, and parameters and in the reagents used. Invention II recites a method of purifying hematopoietic cells; Invention III recites a method of reconstituting hematopoietic; Invention IV recites a method of gene therapy; Invention V recite a method of separating normal cells from neoplastic leukemia cells; Invention VI recites a method of treating leukemia cells; Invention VII recites a method of treating solid tumors; Invention VIII recites a method of determining the presence of SCF receptors in a cell and Invention IX recites a method of modifying the sensitivity to cell cycle-specific chemotherapeutic agents. The examination of all groups would require different searches in the U.S. PATENT shoes and the scientific literature and would require the consideration of different patentability issues. Thus Inventions II-IX are separate and distinct in having different method objectives, and parameters and in the reagents used and are patentably distinct.

Inventions I and (II, III, and V-IX) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibody of Group I can be used in any one of the materially different methods of Groups II, III, or V-IX.

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3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and different classifications, restriction for examination purposes as indicated is proper.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry R. Helms, Ph.D, whose telephone number is (703) 306-5879. The examiner can normally be reached on Monday through Friday from 7:00 am to 4:30 pm, with alternate Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

6. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-7401.

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Respectfully,

Larry R. Helms Ph.D.

A handwritten signature in black ink, appearing to read "Sheela Huff". The signature is fluid and cursive, with the first name "Sheela" written in a larger, more prominent script than the last name "Huff".

SHEELA HUFF
PRIMARY EVALUATOR